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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,834	01/29/2004	Yoshiki Nobuto	248226US0	2367
22850	7590	11/27/2006	EXAMINER	
C. IRVIN MCCLELLAND OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			STEELE, JENNIFER A	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/765,834

Applicant(s)

NOBUTO ET AL.

Examiner

Jennifer Steele

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 7 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Election/Restrictions***

1. Applicant's election with traverse of 1-6 in the reply filed on 4/03/06 is acknowledged. Applicant's grounds for traversal are not clear or persuasive. In the restriction requirement, the examiner set forth an alternative process resulting in the same product. Applicant has not shown that the alternative process does not provide the claimed product.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. The terms "partially stick" and "substantially stick" in claim 2 and claim 5 are relative terms which renders the claims indefinite. The term "partially stick" and "substantially stick" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Claims 2 and 5 refer to the leather-like sheet substrate but the indefinite terms fail to claim a specific distinction of this claimed product.

3. The term "suede-finished" and "grained leather-like sheet" in claim 4 and 6 are relative terms which render the claims indefinite. The term "suede-finished" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of

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the scope of the invention. Claim 4 refers to claim 1 but the term "suede-finished" is not defined and therefore claim 4 makes indefinite reference to the product claimed in claim 1.

***Claim Rejections - 35 USC § 102(e)***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

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4. Claim 1-2 and 4-6 rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6767853 to Nakayama et al. which teaches a fibrous substrate for artificial leather comprising of microfine fiber bundles of (A) and (B) where (A) is elastic and (B) is non-elastic. This rejection is detailed in previous Office Action of 5/18/2006.

***Claim Rejections - 35 USC § 102(b)***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1-2, and 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Takeshi et al EP 1067234 A.

6. The Takeshi reference teaches a fibrous substrate for artificial leather, comprising microfine fiber bundles of elastic fibers (A) and a microfine fiber bundles of nonelastic fibers (B). The weight ratio of (A) to (B) bundles is 10/90-60/40. The current application teaches a fibrous substrate with weight ratio of (A) and (B) bundles within this range of 30/70 and 70/30.

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7. The Takeshi reference teaches 3-50 numbers of microfine fibers (A) or fineness 0.5 denier or less which is considered the same as current application claim 1 of 10-100 microfine fibers of 0.5dtex. MPEP 2131.03 and MPEP 2131.02 102/103

8. The Takeshi reference teaches 15 or more numbers of microfine fibers (B) while the current application does not specify the number of (B) microfine fibers.

9. While Takeshi does not teach that microfine fibers (A) have a JIS A hardness between 90-97, this claim is not considered distinct because "when the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention the examiner has basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980)."

10. Takeshi teaches that (B) encircle (A). Claims 1-2, 4-6 of the current application do not teach the location of (A) and (B) bundles in the fiber-entangled nonwoven and therefore the Takeshi reference is still considered prior art.

11. Takeshi, claim 5, teaches impregnating the substrate with an elastic polymer as stated in Claim 1.

***Claim Rejections - 35 USC § 103***

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claim 3 rejected under 35 U.S.C. 103(a) as being unpatentable over Takeshi in view of Minami, EP 1213377 A1. Takeshi discloses an artificial leather material as set forth in the preceding paragraph. Takeshi differs from the claimed invention because it does not teach that a powder is present within the fibrous material of (A). Minami teaches use of a powder affixed in nonwoven fabric manufactured from islands-in-sea type fibers. Minami claims a powders-affixed nonwoven fabric comprising of powders less than 50 micron, affixed in fiber web of fiber diameter of 4 micron or less with a length of 3 mm or less and cite examples using fibers of 0.5 denier. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated a fine particle into the entangled non-woven substrate motivated by the expectation that this would enhance fibrillation of the fiber material of Takeshi.

13. Claim 3 rejected under 35 U.S.C. 103(a) as being unpatentable over Takeshi in view of either Kato et al US 4476186 or US 4612228 which references using fine particles or fillers to form the grain and facilitate fibrillation. See US 4476186 col. 1 line 50 and US 4612228 col. 9 lines 4-31. . Takeshi discloses an artificial leather material as set forth in the preceding paragraph. Takeshi differs from the claimed invention because it does not teach that a powder is present within the fibrous material of (A). Kato's inventions claim Ultrafine Fiber Entangled Sheet non-woven fabrics having a fiber structure that comprises a portion (A) of ultrafine fiber bundles entangled with (B) of ultrafine fiber bundles. Kato's inventions both reference various fillers and fine particles that can be added to improve grain and fibrillate fibers. Therefore it would have obvious to one of ordinary skill in the art at the time the invention was made to have incorporated a fine particle into the entangled non-woven substrate sheet motivated by the expectation of improved grain and fiber fibrillation.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422



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F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 1,2,4-6 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 and 15 of U.S. Patent No. 6767853.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim a fibrous substrate for artificial leather-like fabric comprising microfine fiber bundles (A) and (B).

### ***Response to Amendment***

Applicant's arguments filed 5/18/2006 have been fully considered but they are not persuasive.

Applicants respectfully disagree with Examiner's previous Office Action allegation that in paragraph 5 "The elastic fibers (A), and bundles formed therefrom, are analogous to the claimed microfine bundles (A) comprising 10-100 microfine fibers." In the same paragraph, Examiner further states "the fiber bundles (B) are analogous to the

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claimed microfine fiber bundle (B).” In response, Applicants refer to column 3, lines 28-45, Nakayama et al (US 6767853) which states that microfine fiber bundles, “*each*” of which is composed of microfine fibers (A) and microfine fibers (B). Applicants further state that the claimed sheet substrate is composed of *two kinds of fibers bundles*.

According to claim 1 of current application, there is no claim of *two kinds of fiber bundles*. Claim 1 states “A ...fabric that comprises a microfine fiber bundle (A) and a microfine fiber bundle (B).

Nakayama et al claim 1 reads “A fibrous substrate for artificial leather, comprising microfine fiber bundles, each of which is composed of ....microfine fibers (A) .....and ....microfine fiber (B) ...wherein the elastic fibers (A) and the non-elastic fibers (B) are substantially dispersed in the whole of any cross section of the bundle”. Further in Nakayama claim 1, “the microfine fiber bundles satisfying the following conditions (1)-(3): ...(3) the microfine fibers (B) encircle each of the microfine fibers (A)”. In process claim 7, the applicant refers to “blending the microfine fiber-forming fiber (A') and the microfine fiber-forming (B') so that a blending ratio of the microfine fiber bundle (A) to the microfine fiber bundle (B) is ...”. The claimed application uses “open” claim language and makes no reference as to how the microfine fibers (A) or (B), microfine fiber bundles (A) or (B) are arranged or entangled in their “fiber-entangled nonwoven fabric”.

Applicant refers to the application Detailed Description of the Invention, p16, to indicate how microfine fiber-forming fiber (A') and (B') are produced by an island and sea component method. The remarks then add “The microfine fiber-forming fiber (A')

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and the microfine fiber-forming fiber (B') are blended with each other and then made into a web. Thereafter, the microfine fiber-forming fiber (A') and the microfine fiber-forming fiber (B') are converted respectively into the elastic fiber bundle (A) and the non-elastic fiber bundle (B)." This language does not specifically state how (A') and (B') become bundles before they are blended. Once the web is formed, (A) and (B) are both present together.

The applicants assert that the elastic fibers and the non-elastic fibers in the claimed sheet substrate exist in a configuration, which is quite distinct from that of Nakayama et al where the non-elastic fibers are required to encircle each elastic fiber. The claimed distinct configuration is not defined in the claims other than by the process of blending.

Applicants note that the present application has been assigned to Kuraray Co. Ltd by Assignment. Applicants submit that the present invention and the invention as described by Nakayama et al were, at the time of the invention was made, owned by, or subject to an obligation of assignment to, the same person/entity. Applicants request that the Examiner acknowledge that Nakayama et al is not longer available as a reference for purposes of obviousness under the above-mentioned provisions granted to Applicants by 35 U.S.C. § 103 (c). However, since the Examiner maintains the 102(e) rejection and continues to reference Nakayama as a 102(e) reference, a showing under 103(c) is not sufficient to remove this grounds of rejection.

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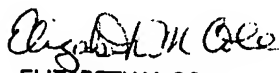
The objection to Claim 3 as being dependent upon a rejected base claim is believed to be obviated by the arguments above. This argument is accepted, however the current Office Action rejects Claim 3 per U.S.C. 35 § 103.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Steele whose telephone number is (571) 272-1478. The examiner can normally be reached on Office Hours Mon-Fri 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
ELIZABETH M. COLE  
PRIMARY EXAMINER